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03/25/99

*Below is a communication from the EXAMINER in charge of this application*

COMMISSIONER OF PATENTS AND TRADEMARKS

#### ADVISORY ACTION

THE PERIOD FOR RESPONSE:

- a)  is extended to run \_\_\_\_\_ or continues to run \_\_\_\_\_ from the date of the final rejection  
b)  expires three months from the date of the final rejection or as of the mailing date of this Advisory Action, whichever is later. In no event however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

Appellant's Brief is due in accordance with 37 CFR 1.192(a).

Applicant's response to the final rejection, filed 3-1-99, has been considered with the following effect, but it is not deemed to place the application in condition for allowance:

1.  The proposed amendments to the claim and/or specification will not be entered and the final rejection stands because:
  - a.  There is no convincing showing under 37 CFR 1.116(b) why the proposed amendment is necessary and was not earlier presented.
  - b.  They raise new issues that would require further consideration and/or search. (See Note).
  - c.  They raise the issue of new matter. (See Note).
  - d.  They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
  - e.  They present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

2.  Newly proposed or amended claims \_\_\_\_\_ would be allowed if submitted in a separately filed amendment cancelling the non-allowable claims.

*Request for Reconsideration*

3.  Upon the filing an appeal, the proposed amendment  will be entered  will not be entered and the status of the claims ~~will~~ are ~~has been~~ as follows:

Claims allowed: none

Claims objected to: none

Claims rejected: 131-135 and 137-161

However,

Applicant's response has overcome the following rejection(s): \_\_\_\_\_

4.  The affidavit, exhibit or request for reconsideration has been considered but does not overcome the rejection because of reasons of record that are more fully discussed in the attached "Further Expl. of T. & R." #4.

5.  The affidavit or exhibit will not be considered because applicant has not shown good and sufficient reasons why it was not earlier presented.

The proposed drawing correction  has  has not been approved by the examiner.

Other Ronald J. 1449

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Further Explanation of Item 4 on the attached Advisory Action:

The rejection of claims 131-135 and 137-161 under 35 U.S.C. § 112, first paragraph, due to NEW MATTER is maintained.

Applicants argue that the instant specification entirely describes probes via their complexity character, citing several such citations. It is noted that all of these citations which clearly cite complexity also cite 50 kb of complexity as the closest numeric value to the present 40 kb in the instant claims. It is also noted that the complexity character of a nucleic acid is different from the length character due to only counting unique sequence therein and not reiterated, repetitive, or repeated sequence. Therefore, the length and complexity of a nucleic acid is most frequently, but not always, different. The one citation that gives 40 kb as a numeric value for a probe on page 38, lines 8-11, lacks any complexity wording. It is well known in the art that a citation such as 40 kb is first interpreted as being a length rather than a complexity.

Additionally, applicants argue that probes in the instant disclosure are characterized by complexity and not length. This argument is non-persuasive because this allegation is not supported by the factual evidence in the specification. For example, on page 76, lines 4-9, various probes are characterized by lengths and not complexity. On page 29, lines 12-14, a probe is characterized by length and not complexity.

It is also noted that applicants have not amended the specification to indicate the status of the appropriate parent applications as previously requested.

Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (See 37 CFR § 1.6(d)). The CM1 Fax Center number is either (703) 308-4242 or (703) 305-3014.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., whose telephone number is (703) 308-3894. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones, can be reached on (703) 308-1152.

Any inquiry of a general nature or relating to the status of this application should be directed to the Chemical Matrix receptionist whose telephone number is (703) 308-0196.

March 24, 1999

*Ardin H. Marschel*  
ARDIN H. MARSCHEL  
PRIMARY EXAMINER